REMARKS

This Request for Reconsideration is submitted in reply to the Office Action dated August 20, 2004 (the "Office Action"), in which the Examiner rejected all 40 pending claims. Applicants respectfully request reconsideration of the claim rejections for at least the reasons set forth below.

This reply is submitted within the 3-month shortened statutory period, and therefore no fees are believed to be due in connection herewith. In the event any fees are required, however, the Commissioner is hereby authorized to charge such fees to the undersigned's deposit account No. 50-0206.

STATUS OF THE CLAIMS

Claims 1-40 are pending in the application.

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) by U.S. Pat. No. 6,233,566 to Levine *et al.* ("Levine")

Claims 21-34 stand rejected under 35 U.S.C. § 103(a) by Levine in view of U.S. Pat. No. 6,370,516 to Reese ("Reese"), U.S. Pat. No. 6,317,726 to O'Shaughnessy ("O'Shaughnessy) and U.S. Pat. No. 6,629,082 to Hambrecht *et al.* ("Hambrecht").

Claims 35-40 stand rejected under 35 U.S.C. § 103(a) by Levine in view of U.S. Pat. No. 5,848,400 to Chang ("Chang"), O'Shaughnessy and Hambrecht.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-20

In the August 20, 2004 Office Action ("Office Action"), the Examiner rejected claims 1-20 under 35 U.S.C. § 103(a) as allegedly being disclosed by Levine. The primary point of contention with regard to claims 1-20 is whether Levine discloses "weightable search information comprising user-selected quantitative search criteria

and user-selected weighting criteria, the weighting criteria reflecting user-defined levels of importance for one or more of the quantitative search criteria." In support of the rejection, the Examiner cites to Levine at column 22, lines 54-56, which states: "The summary may also include information such as weighted averages of FICO score, loan term, loan rate, combined loan-to-value ratio and debt ratio of the loans in the pool." The Examiner also states that "[t]he weighting criteria within the context of applicant's invention are more flexible than Levine's, but would have been obvious to an ordinary practitioner of the art at the time of applicant's invention." Office Action, pp. 2-3. The Applicants respectfully traverse.

To begin with, the portion of Levine to which the Examiner cites as allegedly disclosing "weighted ***search*** information," as that term is used in the present invention, actually discusses providing weighted ***results*** that are provided in response to a user query. *See* Levine, col. 22, ll. 49-59 (discussing preparing summary information that is provided to the user as search results). In contrast, the present invention claims inputting weightable ***search information***. Even beyond this substantial distinction is the fact that Levine clearly uses the term "weighted average" in its conventional mathematical sense as a statistical measure, whereas the present invention claims "weightable search criteria" having "weighting criteria reflecting user-defined levels of importance for one or more of the quantitative search criteria." While the Examiner should give claim terms their "broadest reasonable interpretation," this interpretation **must** be "***consistent with the specification.***" M.P.E.P. § 2173.05(a), *citing In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997), *and In re Prater*, 415 F.2d 1393 (C.C.P.A. 1969). Interpreting the mathematical "weighted average" search results as being the same as the user-defined weighted search criteria of the claimed invention is clearly inconsistent with the specification of the present invention and the clear language of the claims.

The nature and utility of the weightable search criteria of the present invention are described in detail at page 7, line 11 to page 9, line 16 of the specification and elsewhere in the application. For example, one notable benefit that can be derived from

allowing the user to weight the search information is the ability to provide search results that actually *do not* match the user's search variables, but are close to meeting the most important of the user's quantitative search variables, as defined by the user's weighting criteria. *See* Specification, p. 8, ll. 12-15 ("other mutual funds matching the qualitative criteria, but lacking the income fund category, may also be presented for completeness and flexibility"); *and* Fig. 2(n) (showing an exemplary "Analysis of the Match Score" in which one "important preference" is met, while two other "important preferences" are not met). The use of weighting criteria also helps the user sort large volumes of candidates according to the user's particular needs, as defined by the weighting criteria. *See* Specification, p. 8, ll. 5-8 ("a consumer at client 118 may receive a broad compilation of search results reflecting a collection of complex information, but sorted according to that user's particular needs"); *and* Fig. 2(e), ll. 6-9 ("funds with high match scores more closely match the criteria you selected, weighted by the relative importance you assigned to each, than funds with low match scores").

In contrast to the present invention, Levine discloses a system that allows users to enter particular search criteria (such as "Interest Rate" and "Loan/Value Ratio") to search a database of available loans and loan packages. Each user can establish rules for setting the search criteria. For example, a user might only be interested in loans having an Interest Rate of 13% or greater, and a Loan/Value Ratio of 115 or less. *See* Levine col. 9, ll. 11-49. Notably, however, Levine ***fails*** to indicate that a user can apply user-defined ***weighting*** criteria (*e.g.*, rankings) to these search criteria to indicate ***the relative importance of each variable to the user***, as provided by the present invention. For example, Levine ***fails*** to disclose a system in which a user can indicate that the Interest Rate criterion is *more (or less) important* than the Loan/Value Ratio. As a consequence, Levine necessarily ***also fails*** to teach or suggest a system that can provide results that are sorted by a user-selected level of importance, or provide search results that do not necessarily meet all of the quantitative search criteria, but still satisfy the customer's most important requirements, as provided by the present invention. This is made

abundantly clear in Levine's repeated statements that loans that do not meet the criteria are *skipped* or *declined*. *See* Levine col. 22, ll. 19-21; *and* ll. 28-30 ("If the loan does not fall within any buyers' pre-set rules, notification step 1512 is *skipped*...Those loans meeting the selected criteria would be automatically accepted, while all other loans would be *declined*") (emphasis added).

In view of the foregoing, it is clear that Levine fails to disclose the recited feature of "weightable search information comprising user-selected quantitative search criteria and user-selected weighting criteria, the weighting criteria reflecting user-defined levels of importance for one or more of the quantitative search criteria," as these terms are understood in a manner consistent with the present specification. This also appears to be the reason that the Examiner relies on an obviousness-type rejection, rather than an anticipation rejection, in the most recent rejection of claims 1-20.[1]

The Examiner apparently attempts to correct Levine's failure to show a system in which users can apply their own user-selected weighting criteria to the quantitative search criteria by alleging that "[t]he weighting criteria within the context of applicant's invention are more flexible than Levine's, but would have been obvious to an ordinary practitioner of the art at the time of applicant's invention." Office Action, pp. 2-3. The Examiner provides no further support for this modification to the Levine patent, either by demonstrating a motivation to change the statistical weighted average results of Levine into subjective user-weighted search criteria, or by documenting prior art showing the use of such subjective user-weighted search criteria. In view of the absence of specific citations to Levine or other art that shows this feature of the invention with respect to claims 1-20, it appears that the Examiner is taking "official notice" of this allegedly obvious modification.

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[1] The Applicants note that, prior to the most recent amendment adding language relating to the user-selected search and weighting criteria, the Examiner's rejection of claim 1 was based on 102(e) anticipation.

The taking of official notice of is proper only when the facts are "capable of such instant and unquestionable demonstration as to defy dispute." *In re Ahlert*, 424 F.2d 1088, 1091, 165 U.S.P.Q. 418, 420 (C.C.P.A. 1970) (citations omitted), *see also* M.P.E.P. § 2144.03(A). Furthermore, when taking official notice the examiner "must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." M.P.E.P. § 2144.03(B) (citing *In re Soli*, 317 F.2d 941, 137 U.S.P.Q. 797 (C.C.P.A. 1963)).

The Applicants respectfully submit that neither of these conditions for taking official notice is met in the present case. With regard to the alleged fact in dispute being capable of instant and unquestionable demonstration, the Applicants note that there is no basis for alleging that it would be known to modify Levine, which illustrates providing statistical weighted average ***results***, to instead have user-defined weightable ***search*** information in which the user selects quantitative criteria then applies user-selected weighting criteria reflecting the user's own subjective level of importance on each of the quantitative criteria. This is evidenced, for example, by the fact that the Examiner has not set forth any technical or scientific reasoning for concluding that such a modification is common knowledge. As such, it is submitted that taking of official notice of this important feature of the claimed invention is improper, and documentary evidence is respectfully requested to support this contention, as required by M.P.E.P. § 2144.04(C) and judicial precedent on point. *See, e.g., In re Zurko*, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001).

In summary, as demonstrated by the foregoing comments, the 35 U.S.C. § 103(a) rejection of claims 1-20 based on Levine is improper because Levine fails to teach or reasonably suggest the feature of "weightable search information comprising user-selected quantitative search criteria and user-selected weighting criteria, the weighting criteria reflecting user-defined levels of importance for one or more of the quantitative search criteria." Furthermore, the attempt to correct this deficiency by taking official notice that "[t]he weighting criteria within the context of applicant's invention are more

flexible than Levine's, but would have been obvious to an ordinary practitioner of the art at the time of applicant's invention" is improper and is not supportable in the documented evidence. In view of at least the foregoing comments, reconsideration and allowance of claims 1-20 is respectfully requested.

Claims 21-34

Claims 21-34 stand rejected under 35 U.S.C. § 103(a) as allegedly being disclosed by Levine in view of Reese, O'Shaughnessy and Hambrecht. The primary issues with respect to this rejection are whether the cited references render obvious the features of "weightable search information" and "search results comprising investment funds that at least partially satisfy the user-selected quantitative search criteria and the user-selected weighting criteria." The applicants respectfully traverse the rejection, as the cited references fail to teach or suggest these features and therefore do not present a *prima facie* case of obviousness.

The Applicants first note that claims 21-34 recite a system and method having a "weightable search information" feature that is substantially the same as in claim 1. As such, the points made in the foregoing section with regard to claims 1-20 are equally applicable here to demonstrate that Levine fails to disclose this feature. Furthermore, Reese, O'Shaughnessy and Hambrecht do not correct this deficiency. As such, the Applicants respectfully submit that the Examiner has not made a *prima facie* case of obviousness with respect to this feature.

Turning now to the claimed feature of "search results comprising investment funds that at least partially satisfy the user-selected quantitative search criteria and the user-selected weighting criteria," the Examiner admits that "Levine does not explicitly disclose" this feature, and therefore combines Levine with Reese to correct this deficiency. *See* Office Action at p. 4. The Examiner alleges that a motivation to combine these references exists because it would permit a user to save time by using "a highly automated search tool capable of producing search results which partially satisfy a user's search and weighting criteria." Office Action, p. 5. The Examiner cites to Reese

at column 1, lines 59-65 in support of this combination. The Applicants respectfully traverse this rejection on the grounds that the combination of references is improper, as explained below.

At column 1, line 66 to column 2, line 12, Reese describes two types of prior art searching systems. The second type of prior art described by Reese includes systems that use "screens" to sort through data. *See* Reese at col. 2, ll. 4-12. These so-called "screen" systems apply search criteria as a filter to the entire universe of data. The results of the "screen" comprise all of the data meeting the search criteria. *Id.* The Levine reference describes ***exactly*** this type of "screen" system. For example, at column 14, lines 32 to 64, Levine describes an investor using rules to search for available loans. Examples of these rules include "only loans made to borrowers having a FICO score greater than 600 and an interest rate of 13% or greater." Levine, col. 14, ll. 59-60. The Levine system then notifies the user when loans meeting these criteria are posted for sale. *Id.* at ll. 62-64.

Notably, Reese specifically states that "*these prior arts are* ***not applicable to the present invention.***" Reese, col. 2, ll. 13-15. As such, Reese specifically ***teaches against*** being combined with the Levine system, making the combination improper. *See* M.P.E.P. § 2145(X)(D). In fact, the whole purpose of Reese is to move away from requiring the user to input any sort of user-selected search criteria at all. This is made abundantly clear in the discussion at column 2, lines 13-29, where Reese states that "[t]he only input required by the user is the company name or stock selection ID," and that "[a]ll the user has to do is input the company name or security ID." This feature, Reese claims, makes it "entirely different from the prior art." *Id*, col. 2, ll. 28-29. In light of Reese's stated purpose of ***eliminating*** the user's need to enter elaborate search criteria, as required by Levine, combining Reese with Levine to ***incorporate*** such elaborate search criteria into Reese would necessarily result in rendering Reese ***unsatisfactory*** for its stated purpose. This also renders the combination of Reese and Levine improper. *See In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); *and*

M.P.E.P. § 2143.02. Furthermore, if one were to combine Levine with Reese to arrive at the present claimed invention, one would force the Reese device to operate by receiving multiple complex input criteria (the weightable search criteria), which would also change Reese's principle of operation. This also renders the combination improper. *See In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); *and* M.P.E.P. § 2143.02. For at least these reasons, it is clear that no motivation exists to combine Reese with Levine, and therefore the combination and rejections based thereon are improper.

In view of the foregoing comments, the Applicants respectfully submit that there is no *prima facie* case of obviousness with respect to the claimed feature of "weightable search information," as explained above with respect to claims 1-20, and no *prima facie* case of obviousness with respect to the "search results" feature, as explained immediately above. For at least these reasons, the Applicants request reconsideration and allowance of claims 21-34.

Claims 35-40

Claims 35-40 stand rejected under 35 U.S.C. § 103(a) as allegedly being disclosed by Levine in view of Chang, O'Shaughnessy and Hambrecht. The primary issue with respect to this rejection is whether the cited references render obvious the feature of "weightable search information." The applicants respectfully traverse the rejection, as the cited references fail to teach or suggest this features and therefore do not present a *prima facie* case of obviousness.

Here again, the Applicants note that claims 35-40 recite a system having a "weightable search information" feature that is substantially the same as recited in claim 1. As such, the points made in the foregoing section with regard to claims 1-20 are equally applicable here to demonstrate that Levine fails to disclose this feature. Furthermore, Chang, O'Shaughnessy and Hambrecht do not correct this deficiency. As such, the Applicants respectfully submit that the Examiner has not made a *prima facie* case of obviousness with respect to this feature.

In view of the foregoing comments, the Applicants respectfully submit that there is no *prima facie* case of obviousness with respect to the claimed feature of "weightable search information," as explained above with respect to claims 1-20. For at least this reason, the Applicants respectfully request reconsideration and allowance of claims 35-40.

CONCLUSION

Applicants respectfully submit that the current claims are in condition for allowance. As such, reconsideration of the rejections and allowance of the claims are respectfully requested. If the Examiner believes that prosecution might be advanced by discussing the application with Applicants' counsel, in person or by telephone, Applicants' counsel would welcome the opportunity to do so.

Respectfully submitted,
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